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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,379	09/25/2003	Thomas K. McDonald	BEAER:65632	1868

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EXAMINER

RAGONESE, ANDREA M

ART UNIT PAPER NUMBER

3743

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,379

Applicant(s)

MCDONALD ET AL.

Examiner

Andrea M. Ragonese

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on March 14, 2005 has been entered. The Office Action Summary (PTOL-326), mail date January 12, 2005, improperly stated that the corresponding Office action was both a final AND a non-final action. However, the previous Office action was a **non-final** action, thus, making the Applicant's amendment after a non-final rejection, not a final rejection.

Examiner acknowledges that **claim 22** has been amended. Subsequently, **claims 22-34** are under consideration.

Response to Arguments

2. Applicant's arguments filed March 14, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the visor **18** of Shoemaker et al. (US 4,595,003) is not of "optical quality," the Examiner strongly disagrees. Since visor **18** is a face mask through which a user may look to view the surroundings, then the visor **18** of the prior art fully meets the claim limitation of "optical quality." As defined by the *Merriam-Webster Online Dictionary*, "optical" is "of or relating to vision." In this case, since objects can be viewed through the visor **18**, then it is of "optical quality." In addition, Applicant does not establish criticality of this specific claim limitation. Despite close reading of the specification, Examiner fails to ascertain the novelty in disclosing this specific quality of the mask material and therefore, the argument fails to distinguish the instant invention over the prior art.

In response to applicant's argument that the mask **10** of Shoemaker et al. is capable of "deflecting to conform to a wearer's face and for storage," the Examiner strongly disagrees. First, recitations of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Specifically, the mask **10** is **fully capable** of "deflecting to conform to a wearer's face and for storage." Applicant has claimed to what degree the mask must be folded in order to be considered in a "storage" position, thus, the prior art of record meets the claim limitation since the mask **10** must only be capable of being deflected into a "storage" position, which could be any position or orientation in which the mask is ever so slightly deflected. Shoemaker et al. also offers support for the limitation of "deflecting to conform to a wearer's face" in column 4, lines 25-42. Shoemaker et al. states, "Mask **10** is molded of a transparent silicone elastomer in a thickness sufficient to make it semi-rigid but still thin enough to permit visor **18** to deflect sufficiently under urging..." The term "semi-rigid" means that the mask **10** has the capability of being flexed to some degree.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 22-29 and 31-34** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shoemaker et al. (US 4,595,003). Regarding **claims 22, 23, 26-29, 31, 32 and 34**, Shoemaker et al. discloses a quick-donning full face oxygen mask **10** including a flexible mask assembly **12** having a flexible periphery **16** conformable to a wearer's face and a flexible optical lens **18** of optical quality disposed in the flexible mask assembly **12**, which allows a wide field of view to the wearer as shown in Figure 1. The mask **10**, and its components, are "molded of a transparent silicone elastomer" such as "silicone elastomer X4-2665, made by Dow Corning" (column 4, lines 25-42). Regarding **claims 24, 25 and 33**, the flexible optical lens **18** is "coated on both sides with urethane from a solvent bath to improve the abrasion resistance of the mask" (column 4, line 67 through column 5, line 16).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. **Claim 30** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoemaker et al. (US 4,595,003), as applied to **claims 22-29** and **31-34** above, in view of Aulgur et al. (US 4,915,106) or Dubruille et al. (US 5,630,412). Shoemaker et al. discloses a quick-donning full face oxygen mask **10** comprising all the limitations recited in **claim 30**, with the exception of an inflatable harness formed of silicone tubing. However, the use of an inflatable harness formed of silicone tubing was known at the time the invention was made. Specifically, Aulgur et al. or Dubruille et al. teaches the use of "a harness strap which can be inflated to a somewhat rigid, self-sustaining orientation to permit one-handed placement of the respirator over the wearer's head" ('106, Abstract) or a "harness...capable of pressing the mask against the face with sufficient force to prevent leaks" ('412, column 1, lines 22-38). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the mask of Shoemaker et al. by adding an inflatable harness formed of silicone tubing because it is well known in the art, as taught by Aulgur et al. or Dubruille et al., to utilize an inflatable harness in order to secure a breathing apparatus snugly, yet comfortably, to the wearer's head.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese** whose telephone number is **571-272-4804**. The examiner can normally be reached on Monday through Friday from 9:00 am until 5:00 pm.

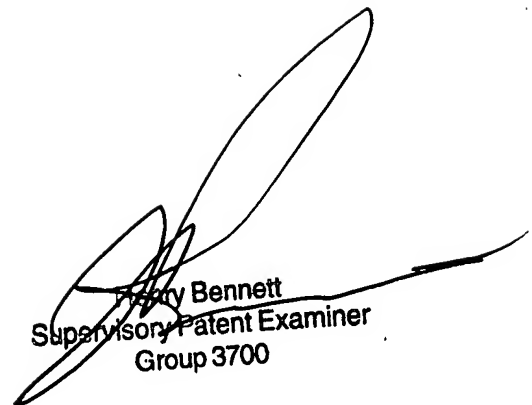
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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AMR
May 31, 2005



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